

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOREN D. ALEXANDER,
LLOYD L. PIPER, II, THADDEUS S. DZIERZBICKI,
and CEM M. GOKCEN

Appeal No. 1997-0674
Application 08/214,971¹

ON BRIEF

Before ABRAMS, STAAB, and GONZALES, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claims 1-16, which constitute all of the

¹ Application for patent filed March 17, 1994.

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claims of record in this application.

The appellants' invention is directed to a method of encapsulating waste material for safe disposal thereof (claims 1-15) and to a waste encapsulation system (claim 16). The claims before us on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Stein <i>et al.</i> (Stein) 1989	4,886,164	Dec. 12,
Gallo <i>et al.</i> (Gallo) 1993	5,186,351	Feb. 16,
Mains <i>et al.</i> (Mains) 1993	5,196,132	Mar. 23,

THE REJECTION

Claims 1-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stein in view of Gallo and Mains.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellants regarding the rejection, we make reference to the final rejection (Paper No. 9) and the Examiner's Answer (Paper

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No. 12) for the reasoning in support of the rejection, and to the Appellants' Brief (Paper No. 11), for the arguments thereagainst.

OPINION

The objective of the appellants' invention is to provide a waste treatment method and system that incorporate the ease of conventional waste containers combined with secure, safe disposal (specification, page 3). In furtherance of this, method claim 1 sets forth the steps of providing a rigid container having disposed therein a liner of sufficient rigidity that it is self-supporting in the absence of the rigid container and being substantially impermeable to liquids and substantially resistant to chemical degradation, placing waste material in the liner through an opening, sealing the liner by forming a substantially liquid impermeable seal over the opening thereby encapsulating the waste material in the liner, and removing the liner from the rigid container prior to disposal of the liner containing the waste material. Independent system claim 16 contains similar limitations. On

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page 4 of the Answer, the examiner has taken the following positions:

(1) It would have been obvious to one of ordinary skill in the art to have employed the self supporting material teaching of Gallo, et. al., motivated by the handling requirements and the top seal teaching of Mains, et. al., motivated by the intended container contents, in the construction of the device of Stein, et. al. The method claimed would have been obvious to one of ordinary skill in the art in light of the intended use.

(2) It is well known and widely accepted to separately dispose of waste container liners and contents while retaining the outer container, as in household waste containers, motivated by the cost savings.

We do not agree with these conclusions, from which it follows that we do not agree that the combined teachings of these three references establish a *prima facie* case of obviousness with regard to the subject matter of the appealed claims. Therefore, we will not sustain the rejection. Our reasoning follows.

Stein discloses a container for medical waste such as needles and syringes. It comprises a rigid outer box (10) and a rigid inner box (30), between which is a flexible plastic bag (50). These three elements are attached together (column

2, lines 45-52), as by staples (48). An insert (30) having a slot (46) through which waste is received is disposed inside the inner box. When the inner box is full, the plastic bag is tucked in over the insert and a cover (64, 80 or 90) is placed inside the inner box to close the container. Then, the entire container is disposed of. With regard to the requirements of independent claim 1, Stein does not teach the step of removing the liner containing the waste material from the rigid container. With regard to those of independent claims 1 and 16, Stein does not teach a liner that is of sufficient rigidity to be self supporting in the absence of the rigid container, as well as being substantially impermeable to liquids and substantially resistant to chemical degradation. In this regard, the inner box of Stein is not impermeable to liquids and resistant to chemicals; that which is, the plastic liner, is not self supporting.

A tank especially suited for transporting slurries such as wine grapes is the subject of the Gallo reference. It comprises a rigid frame (5) within which is a plastic container (4). Whether or not the container is self supporting in the absence of the frame is not explicitly

taught. However, it is described as being "supported by" (column 1, lines 37-38) and "supported within" (column 2, line 3) the frame, and is shown in Figure 2 as being within the frame when being emptied, which does not sustain without reservation a conclusion that it is self supporting outside the frame. Also in this regard, there is no mention of the container being operative outside of the frame, or that it and its cargo are handled, much less disposed of, separate from the frame.

Mains discloses a container for a dry cleaning product. It comprises a plastic tub having a sealed plastic top, within which is contained a unit dose of dry cleaning product. When the

container is placed in dry cleaning solvent, it dissolves, allowing the product within to mix with the solvent.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner

to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The three components of the Stein container - the outer box, the inner box, and the intermediate plastic bag - are attached together and are disposed of together. In order to meet the terms of the claims, Stein's inner box, which is rigid, and plastic bag, which provides liquid impermeability and resistance to chemical degradation, would have to be detached from the outer box and replaced with a single element that has these qualities, and is separately disposable. To make these changes would result in completely discarding the Stein method, changing it from throwing away the entire container to throwing away only the inner liner, and would totally reconstruct the Stein container, eliminating all but the outer support and replacing the two inner components with

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one. We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to do so, except for the hindsight accorded one who first viewed the appellants' disclosure. This, of course, is impermissible as a basis for deprecating an invention. See ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

SUMMARY

The rejection is not sustained.

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The decision of the examiner is reversed.

REVERSED

	Neal E. Abrams)	
	Administrative Patent Judge)	
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)	
	Lawrence J. Staab)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	John F. Gonzales)	
	Administrative Patent Judge)	

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